



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/433,497	11/03/1999	THIRU SRINIVASAN	1613(42059-0	2641

20350 7590 12/12/2002

TOWNSEND AND TOWNSEND AND CREW, LLP  
TWO EMBARCADERO CENTER  
EIGHTH FLOOR  
SAN FRANCISCO, CA 94111-3834

EXAMINER

FERRIS, DERRICK W

ART UNIT PAPER NUMBER

2663

DATE MAILED: 12/12/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/433,497

Applicant(s)

SRINIVASAN, THIRU

Examiner

Derrick W. Ferris

Art Unit

2663

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 03 November 1999.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 November 1999 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2. 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Specification*

1. Examiner notes **claim 2** is absent from the filed application.

### *Claim Rejections - 35 USC § 112*

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. **Claims 1 and 3-21** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Examiner notes no clear presentation of the key recited claims features with respect to applicant's embodiments in the specification and drawings. Specifically, examiner notes no specific references of such key features in the specification or drawings cited generally in the claims as a "switching device", "identification device", "network communications interface device", and "a searchable database".

### *Claim Rejections - 35 USC § 102*

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C.

Art Unit: 2663

122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

5. **Claims 22-25** are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,240,449 to *Nadeau*.

As to **claim 22**, using a reasonable but broad interpretation of the recited claimed language (which is very broad), *Nadeau* discloses detecting an incoming signal such as that disclosed in the examples related to figures 3 and 4 [column 11, lines 34-67; column 12 lines 1-65]. Also taught is extracting a destination address from the communications signal and using this extracted term to establishing a connection over a data network (i.e., the Internet) with a database (e.g., the subscriber database) [column 10, lines 31-67]. Given a broad but reasonable interpretation of the claim, information about a subscriber can be obtained from the subscriber database. As noted this information can be retrieved from the database (e.g., a subscriber's number or IP address) and used in establishing a telephonic connection [column 11, lines 13-26].

As to **claim 23**, the Internet can be used as one domain for establishing the call as taught by the reference.

As to **claim 24**, *Nadeau* also discloses using a web browser to modify (i.e., add or delete) subscriber information [column 10, lines 23-27].

As to **claim 25**, *Nadeau* also stores routing information in the subscriber table including time and day of week routing (i.e., a broad but reasonable interpretation of based on the date the incoming communication signal is received) [column 10, lines 8-20].

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. **Claims 1, 3-21 and 26-28** are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,240,449 to *Nadeau*.

As to **claim 1**, *Nadeau* discloses a method and apparatus for automatic call setup in different network domains where a network domain can be the PSTN and Internet [column 1, lines 6-11]. Specifically, *Nadeau* discloses dialing into a system using either a dedicated DN or feature code, and inform the system of the particular individual, listed in his/her subscriber directory to be reached by uniquely identifying the party to be called [column 9, lines 32-47]. As *Nadeau* presents a telephone network in general, and specifically a switching device between a telephone network (i.e., the PSTN) and a data network (i.e., the Internet), examiner notes a strong motivation to apply the subject matter as a whole for the reference.

Noted in the previous 112-second paragraph it is unclear from applicant's vague use of terms on what is meant by a "switching device" in light of applicant's specification and drawings (e.g., applicant's figure 1 shows several switching devices). Examiner notes given the very broad functionality recited in the claims that *Nadeau* discloses such a generic "switching device" with interface device and network communications interface

Art Unit: 2663

device. Specifically, examiner notes the specific examples disclosed by *Nadeau* with respect to figures 3 and 4 [column 11, lines 34-67; column 12 lines 1-65]. As *Nadeau's* invention is directed to setting a call in different domains, figure 3 establishes a call between an IP to PSTN network and figure 4 establishes a call between two IP networks or domains. The important feature to note between these two examples is the relationship between the ACS gateways (i.e., the PSTN ACS gateway 108 for figure 3 and the Internet ACS gateway 116 for figure 4) and the ACS Service Logic Controller 122 since this may be a potential point at issue with respect to the vaguely recited claimed feature: “and receives connection information which is employed by the switch to establish a telephone connection with the callee”. (Examiner uses a broad but reasonable interpretation of this functionality as a “switching device”.) It is unclear from the recited claimed subject matter on what is meant by “to establish a telephone connection”. As such, examiner notes in light of applicant's specification and drawings that the *Nadeau* patent discloses similar functionality such that it would have been obvious to a skilled artisan prior to applicant's invention to employ this functionality in various types of switching devices for the purpose of establishing a connection. Specifically, examiner notes *Nadeau* discloses a logical functionality in the figures, this logical functionality being able to reside on various physical devices (e.g., a switching device in general) depending on the type of call (e.g., figures 3 and 4). Hence a skilled artisan would be motivated to use this information to obtain information from the subscriber database 204 (i.e., part of the ACS Service Logic Controller 122 shown in figure 2) for the purpose of

Art Unit: 2663

establishing the call without departing from the spirit and scope of the invention [column 10, lines 31-67].

As to **claim 3**, *Nadeau* discloses the “data network” as the Internet.

As to **claim 4**, *Nadeau* discloses several methods for obtaining information from a programmable database in general [column 10, lines 31-67].

As to **claim 5 and 6**, *Nadeau* discloses a subscriber database which can be searched. This information can also covert the destination information depending on the current location of the subscriber [column 11, lines 13-24].

As to **claim 7**, as mentioned in the rejection for claim 1 a PC-to-telephone, and a PC-to-PC call are shown in figures 3 and 4 of *Nadeau* respectively.

As to **claim 8**, shown in figure 4 is a switching device that is a non-advanced intelligent network switch.

As to **claim 9**, again a “network interface device” and “a searchable database” are vaguely defined in applicant’s specification. Examiner notes that given a broad but reasonable interpretation of the claimed subject matter that a “network interface device” is shown by *Nadeau* (in the form of a gateway) and a “searchable database” (in the form of a subscriber database). With respect to a “network interface device”, examiner notes *Nadeau* shows data connections (i.e., the dotted lines) between the ACS gateway device (i.e., PSTN ACS gateway 108 or Internet ACS gateway 116) and the ACS Service Logic Controller 122 shown in figures 3 and 4. Examiner also notes that an IP address (among other elements [column 9, lines 61-67; column 10, lines 1-20]) can serve as an “association value”. Also disclosed by *Nadeau* is a generic processor (shown in figure 2

Art Unit: 2663

as CPU 200) used for a reasonable but broad interpretation of searching and establishing a connection.

Noted in the previous 112-second paragraph it is unclear from applicant's vague use of terms on what is meant by a "network interface device" in light of applicant's specification and drawings (e.g., applicant's figure 1 shows several devices with network interfaces). Examiner notes given the very broad functionality recited in the claims that *Nadeau* discloses such a generic "network interface device" with respect to a data network (i.e., the Internet). Specifically, examiner notes the specific examples disclosed by *Nadeau* with respect to figures 3 and 4 [column 11, lines 34-67; column 12 lines 1-65]. As *Nadeau*'s invention is directed to setting a call in different domains, figure 3 establishes a call between an IP to PSTN network and figure 4 establishes a call between two IP networks or domains. The important feature to note between these two examples is the relationship between the ACS gateways (i.e., the PSTN ACS gateway 108 for figure 3 and the Internet ACS gateway 116 for figure 4) and the ACS Service Logic Controller 122 since this may be a potential point at issue with respect to the vaguely recited claimed feature: "and receives connection information which is employed by the switch to establish a telephone connection with the callee". (Examiner uses a broad but reasonable interpretation of this functionality as a "network interface device".) It is unclear from the recited claimed subject matter on what is meant by "to establish a telephone connection". As such, examiner notes in light of applicant's specification and drawings that the *Nadeau* patent discloses similar functionality such that it would have been obvious to a skilled artisan prior to applicant's invention to employ this



Art Unit: 2663

functionality in various types of network interface devices for the purpose of establishing a telephonic connection. Specifically, examiner notes *Nadeau* discloses a logical functionality in the figures, this logical functionality being able to reside on various physical devices (e.g., a networking interface device in general) depending on the type of call (e.g., figures 3 and 4). Hence a skilled artisan would be motivated to use this information to obtain information from the subscriber database 204 (i.e., part of the ACS Service Logic Controller 122 shown in figure 2) for the purpose of establishing the call without departing from the spirit and scope of the invention [column 10, lines 31-67].

As to **claim 10**, examiner notes that the Subscriber Database mentioned by *Nadeau* discloses time of day routing [column 10, line 9].

As to **claim 11**, examiner notes a broad but reasonable interpretation of using the processor for providing a display of selected subscriber information [e.g., column 10, lines 24-67].

As to **claim 12**, *Nadeau* discloses that the “data network” is the Internet.

As to **claim 13**, *Nadeau* discloses transferring the data signals using various gateways (shown in figures 3 and 4) in general relating to a telephone call received at a switch.

As to **claim 14**, *Nadeau* discloses as part of the call routing, routing a telephone number for a call [column 11, lines 13-25].

As to **claim 15**, as examiner notes that it would have been obvious to a skilled artisan prior to applicant’s invention, using a broad but reasonable interpretation of the claim, to include icons which are selectable to access the selected portions of

Art Unit: 2663

communication information. Examiner notes the motivation is using a web browser which contains such icons as is well known in the art where a web browser in general is disclosed by *Nadeau* for gaining access to a subscriber database [column 10, lines 23-55].

As to **claim 16**, examiner notes in general that *Nadeau* discloses communication between different network domains, such domains being the PSTN and the Internet. Hence using a broad but reasonable interpretation of the claims the network interface device provides for connections over a data network (i.e., the Internet) from a personal computer (e.g., Internet Origination Point shown in figure 4).

As to **claim 17**, examiner notes that using a broad but reasonable interpretation of the claims that the client is able to search the subscriber database using a we browser [column 10, lines 23-55].

As to **claims 18 and 19**, examiner notes *Nadeau* discloses routing information in general based on the subscriber database including a telephone number, home number, directory number, etc.) [column 9, lines 55-67; column 10, lines 1-20]. Examiner notes that using other calling identification information such as a pager number, work number, or cell phone number would have been obvious to use prior to applicant's invention since support for this functionality can be provided by the directory for each subscriber.

As to **claims 20 and 21**, in addition to the reasoning for rejection of claim 18, other information can also be provided in the subscriber database such as routing information (e.g., time of day routing). Examiner also notes a broad but reasonable interpretation of searching in a predetermined order.

As to **claim 26**, not clearly taught by *Nadeau* is searching based on a date table. Instead *Nadeau* discloses routing using either time of day or day or week [column 10, lines 9-10]. Examiner notes that it would have been obvious to a skilled artisan prior to applicant's invention to also apply this to a date in general. The motivation for this being that the routing information in general is stored for a subscriber such as time and day or week information. Such information can be used to make a routing decision [e.g., step 8 in column 11, lines 59-64]. Hence examiner notes that a day and time table can also apply to date table in general.

As to **claims 27-28**, again the specific searching criteria is explicitly not taught by *Nadeau*. Instead *Nadeau* provides the infrastructure to support such a search. This infrastructure consisting of the subscriber database which includes subscriber information in general. Examiner notes that it would have been obvious to a skilled artisan prior to applicant's invention to use this information in the table to find a subscriber. Examiner notes that the motivation for the subscriber database in general is to provide information on locating the subscriber [column 5, lines 34-59].

### ***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- US006463443B1 discloses general information for communication between the PSTN and the Internet for establishing a voice call while using a database to lookup subscriber information [see background].

Art Unit: 2663

- US006021126A also US006463443B1 discloses general information for communication between the PSTN and the Internet for establishing a voice call while using a database to lookup subscriber information [e.g., column 6, lines 59-67; column 7, lines 1-36; and figure 3].


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Derrick W. Ferris whose telephone number is (703) 305-4225.


The examiner can normally be reached on M-F 9 A.M. - 4:30 P.M. E.S.T.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chau Nguyen can be reached on (703) 308-5340. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9314 for regular communications and (703) 872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 305-3900.

Derrick W. Ferris  
Examiner  
Art Unit 2663

DWF   
December 9, 2002

  
MELVIN MARCELO  
MEPRIMA  
PRIMA